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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,006	04/15/2004	Jeanine Hettinga	3792715/58660	7236
26386	7590	12/19/2005	EXAMINER	
DAVIS, BROWN, KOEHN, SHORS & ROBERTS, P.C. THE FINANCIAL CENTER 666 WALNUT STREET SUITE 2500 DES MOINES, IA 50309-3993			HUSON, MONICA A	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/825,006

Applicant(s)

HETTINGA, JEANINE

Examiner

Monica A. Huson

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 101904.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1-5, drawn to a product, classified in class 428, subclass 119.

Claims 6-10, drawn to a process, classified in class 264.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as by molding the closure and then removing portions of the surface thereof to form the markings.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Herink on November 15, 2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 6-10.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (U.S. Patent 5,855,287), in view of Wheeler (U.S. Patent 4,913,639). Regarding Claim 6, Burns shows that it is known to carry out a method of injection molding a bottle closure (Abstract), comprising the steps of providing an injection molding machine having a mold cavity for molding a bottle closure comprising a body member having a generally cylindrical portion and at least one generally circular end portion (Column 6, lines 36-37), creating a plate with reverse markings (Column 7, lines 10-12); injecting an injection mixture into the mold cavity (Column 6, lines 50-57); and discharging a bottle closure having positive markings on one or both of its end portions (Column 7, lines 1-13). Burns does not show a releasable embossing plate. Wheeler shows that it is known to carry out a method of embossing a molded article within a mold including releasably securing the plate in the mold cavity (Abstract; Column 1, lines 6-7, 38-56). Wheeler and Burns are combinable because they are concerned with a similar technical field, namely, methods of in-mold embossing of molded articles. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Wheeler's releasable embossing plate during Burns' molding process because, in the event of damage, it is less expensive to replace an insert plate relative to replacing an integral face of the mold cavity.

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Regarding Claim 7, Burns shows the process as claimed as discussed in the rejection of Claim 6 above, including a method wherein the markings are selected from the group consisting of designs, logotypes, names, information identifying the contents of the bottle, and information identifying the producer of the contents of the bottle (Column 7, lines 10-14), meeting applicant's claim.

Regarding Claim 8, Burns shows the process as claimed as discussed in the rejection of Claim 6 above, wherein the body member has two generally circular end portions (Figure 1), further comprising the steps of forming the reverse markings into another end plate to create substantially identical markings in the send end portion (Column 7, lines 10-14). Burns does not show a releasable embossing plate. Wheeler shows that it is known to carry out a method of embossing a molded article within a mold including releasably securing the plate in the mold cavity (Abstract; Column 1, lines 6-7, 38-56). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to make both of Burns' embossing plates releasable, as taught by Wheeler, because, in the event of damage, it is less expensive to replace an insert plate relative to replacing an integral face of the mold cavity.

Regarding Claim 9, Burns shows the process as claimed as discussed in the rejection of Claim 6 above, including a method further comprising a body member (Figure 1), meeting applicant's claim.

Regarding Claim 10, Burns shows the process as claimed as discussed in the rejection of Claim 9 above, but he does not show a specific configuration of the body member. However, to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte*

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*Pfeiffer* 135 USPQ 31. There is no evidence that the claimed structure has any stepwise effect on the method claimed. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use any various structure of the body member in order to accommodate exclusive end-use specifications.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monica A Huson  
December 12, 2005



MICHAEL P. COLAIANNI  
SUPERVISORY PATENT EXAMINER